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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,845

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Tetsuo Yamaguchi

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5297

2292

7590

05/18/2006

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/791,845	YAMAGUCHI ET AL.	
	Examiner	Art Unit	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 5-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03/04/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 02/21/2006 –
Election.

Claims 1-17 remain pending.

Applicant's election with traverse of Species I (Figures 1-4) in the reply filed on 02/21/2006 is acknowledged. The traversal is on the ground(s) that there is no undue burden placed on the Examiner to examine all of Species I-IV, since the only difference among the species is the specified range for "x" and "y" coordinates such that the search and examination issues for these embodiments overlaps. This is not found persuasive because applicant has failed to submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. Moreover, as the technique described for setting the "x" and "y" coordinates varies with each species, the search and examination would not necessarily overlap, as alleged by the applicant. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. Currently, no allowable generic claims exist in the case.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5-16 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 02/21/2006.

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Following is an action on the MERITS:

Claim Rejections - 35 USC § 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Werner ('150). Under §102, note that Werner details that the thickness of the striking face is greatest at the center, with a gradual thinning towards the peripheral wall. Applicant has detailed at page 7 of the specification that one way of providing the required values of "x" and "y" is to thin the face above the center so that the amount of flexure is increased. Here, Werner has provided an increase in flexure above the center of the face and more particularly in a range greater than 0 mm and smaller than or equal to 10 mm, as measured in a vertical "y" direction from the center of the hitting face. See Figure 3 in Werner.

Alternatively under §103, while the Werner device may not necessarily specify that the thinned face that is 10 mm removed from the center of the striking face is the

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point of maximum resiliency, it is noted that the structure shown by Werner, i.e., the cross-section of face wall showing the curvature and thickness of the face wall (Figure 4 in Werner) substantially mimics the cross-section of the face wall shown by the applicant in Figure 3 of the application. Thus, the fact that the two cross sections being compared are substantially the same would lead the skilled artisan to understand that the maximum point of resilience may be located above the center of the striking face and may not necessarily be at a point on the striking face of least thickness. Moreover, the fact that the Werner face is uniformly constructed of the same material throughout would have provided some guidance to the skilled artisan that the resilience of the face must increase at points further from the center of the face. Werner provides further guidance to the skilled artisan in sizing the face, as Werner teaches that optimum values for the center of gravity location, loft angle and moment of inertia of the club may be obtained through a readjustment of the mass of the face. In view of the teaching in Werner, one of ordinary skill in the art would have found it obvious to locate the point of maximum resilience within 10 mm of the center of the hitting face in a positive "y" direction, as detailed in the claims, the motivation being to provide a desirable amount of flex in the face. Note that the claimed "y" value is only disclosed as being a preferred value [SPECIFICATION, PAGE 7]. No criticality has been established by the applicant for applying the claimed range of "y" values.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner. As to claim 2, note the argument under §103 for claim 1, supra. Here again, one of ordinary skill in the art would have found it obvious to locate the point of

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maximum resilience within 5 to 8 mm of the center of the hitting face in a positive "y" direction, as detailed in the claims, the motivation being to provide a desirable amount of flex in the face. Note that the claimed "y" value is only disclosed as being a preferred value [SPECIFICATION, PAGE 7]. No criticality has been established by the applicant for applying the claimed range of "y" values. As to claims 3 and 4, the value of $(t_2 - t_1)$ is not deemed patentable, as the claimed value is simply set forth so that the club head may conform to a known pendulum test result set forth by the USGA. Applicant has acknowledged that the pendulum test is as described in "Technical Description of the Pendulum Test" and attached to "Notice to Manufacturers", issued from the USGA on February 24, 2003.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by McKeighen ('049). Considering the ranges for the (x, y) coordinate set claimed, there is nothing in the claims which precludes the maximum resilience point from being located at the center of the hitting face. As such, the prior art to McKeighen shows that the striking face is made of uniform material throughout and is thinnest at the center (t_2 value). Thus, the maximum resilience point lies at coordinates (0, 0), which meets the claimed limitations.

Further References of Record

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figures 5-8 in Rugge. Note Figure 2 in Kusumoto. Note Figures 6, 8 and 9 in Boone.

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Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp
May 15, 2006


Sebastiano Passaniti
Primary Examiner